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09/711,786	11/13/2000	Alain Marbach	SAA-49	7181

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EXAMINER

MASINICK, MICHAEL D

ART UNIT PAPER NUMBER

2125

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/711,786

Applicant(s)

MARBACH ET AL.

Examiner

Michael D Masinick

Art Unit

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

Claims 1-28 are pending in this application.

#### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 10, 11, 12, 23, 24 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the specification says only "a search device, such as a web spider, can be coded" but goes into no detail about how this code would work, does not provide a detailed explanation, and does not provide a preferred embodiment. Examiner asserts that this type of system of searching IP address or MAC addresses close to the address of known pieces of equipment is not well known in the art, thus causing undue experimentation to be preformed in order to re-create the invention claimed in these claims.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 25 recites the limitation "the searching means". There is insufficient antecedent basis for this limitation in the claim. Claim 25 is not further treated in this action.

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5. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear from the wording of this claim which parts are meant as preamble and which are claim limitations. Appropriate correction is required. Claim 18 is further treated as best understood.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-9, 13-22, and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,790,604 to Cokey et al in view of U.S. Patent No. 6,038,486 to Saitoh et al.

8. Regarding claims 1 and 20, Cokey shows a method of monitoring a product via a communications network, wherein the product includes identifiable information associated therewith, and the factory automation product is installed at an installation site having an installation site address, said method comprising the steps of and means for: obtaining the installation site address and the identifiable information (Col 8, lines 38-42); and associating the installation site address to the product based on the identifiable information (Col 8, lines 38-42).

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9. Cokey does not show that this product is a factory automation product. Saitoh et al clearly shows a factory automation software based product which can be accessed and used over the internet which controls machine tools and a variety of other factory automation efforts.

10. It would have been obvious to one of ordinary skill at the time the invention was made to implement the software security and licensing system of Cokey as the licensing system of Saitoh or any other factory automation software because "A significant amount of software piracy occurs in commercial settings" (Cokey Col 1, lines 8-46).

11. Referring to claim 2, Cokey shows wherein the identifiable information comprises a MAC address assigned to the product (Col 18, lines 10-23). Examiner notes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a MAC address as the "other suitable hardware identifier" which is clearly shown in Cokey.

12. Referring to claim 3, Cokey shows wherein the identifiable information comprises a serial number ("License ID" – Col 9, lines 52-61 and Col 15, lines 19-20).

13. Referring to claim 4, Cokey shows wherein the identifiable information comprises a version number (Col 9, lines 4-5).

14. Referring to claim 5, Cokey shows wherein the identifiable information comprises a product number (Col 9, lines 1-10).

15. Referring to claim 6, Cokey shows wherein the installation site address is an IP address of the installation site (Col 8, line 42).

16. Referring to claim 7, Saitoh shows where the product is a control device (Figure 1).

17. Referring to claim 8, Cokey clearly shows wherein the product comprises a software product.

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18. Referring to claim 9, Cokey shows wherein the product comprises a host computer (Col 7, lines 43-67).
19. Referring to claims 13 and 14, Cokey shows wherein a user of the product is required to register the product over the communications network, and wherein the identifiable information and installation site address is obtained through said registration (Col 8, lines 38-54).
20. Referring to claims 15-17, Cokey shows where the product is provided with an embedded mechanism capable of providing a message or message containing address related information, installation site address information, and identifiable information, said method further comprising the step of receiving the signal in order to obtain the information. Examiner notes that any piece of code is "embedded" into a software product, this Cokey reads on the claims above as written (Col 8, lines 38-54).
21. Referring to claim 18, Saitoh shows wherein the factory automation system is connected to an equipment, said method further comprising the step of identifying the installation site address of the product based on the connected equipment. Examiner notes that Saitoh clearly shows the ability to communicate over a network with equipment in a fashion well known in the art and that identifying the IP address of a piece of equipment would be no different than any other IP address identification system as is well known in the art or shown in Cokey.
22. Referring to claim 19, Saitoh shows where the factory automation product is associated with a URL in the communications network. Examiner notes that Saitoh clearly shows the ability to communicate over a network with equipment in a fashion well known in the art and that identifying the URL of a piece of equipment would be no different than any other URL identification system as is well known in the art or shown in Cokey.

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23. Examiner further notes in regards to claims 18 and 19 that it is well known in the art that URL's and IP addresses are interchangeable as address links to servers or other computer machinery.

24. Referring to claim 21, Cokey shows wherein the providing means comprises a physical site locator ("IP Address", Col 8 line 42).

25. Referring to claim 22, Cokey shows wherein the providing means comprises an embedded device embedded in the factory automation device. See above rejection of claims 15-17. Examiner views the word "embedded" as part of the computer code which is clearly shown in Cokey.

26. Referring to claim 26, Cokey shows means for notifying a user of the factory automation product safety or quality issues using the installation site address (Col 20, lines 53-64).

27. Referring to claim 27, Cokey shows wherein further information is provided when the product is registered, said associating means further associating the product based on the further information (Col 8, lines 38-43).

28. Referring to claim 28, Cokey shows means for determining whether the product is used in violation of licenses based on the installation site address (Col 15, lines 49-62).

### ***Conclusion***

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and to the state of the art at the time of invention.

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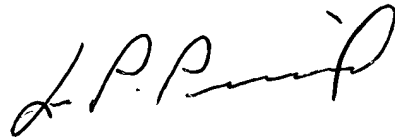
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael D Masinick whose telephone number is (703) 305-7738.

The examiner can normally be reached on Mon-Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached on (703) 308-0538. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

mdm



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